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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,702	03/29/2004	James Nicholas	Nicholas Case 1	1364
7590 04/07/2006			EXAMINER	
Edward M. Fink, Esq. 51 Jamaica Street Edison, NJ 08820			HOWELL, DANIEL W	
			ART UNIT	PAPER NUMBER

3722

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/811,702	Applicant(s) NICHOLAS, JAMES	
	Examiner Daniel W. Howell	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

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1. On line 2 of claim 3, "ion" should be changed to "in."
2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green (3849019) in view of Voissem (3266346). Green shows an annular cutter 20 having a plug ejector. The ejector has a washer 14, pins 16, 18, which extend through holes 28, 30, in the base of the cutter, and springs 32, 34, for retracting the ejector. When the tool is removed from the chuck, the ejector is likely to separate from shank 10 (due to the bias of the springs), possibly becoming lost after the separation. Further, the unsecured fronts of the pins may become canted within the holes over time, causing binding as the move in the base of the cutter. Voissem shows a similar ejector having a rear plate 64, a forward plate 62, and bolts interconnecting the two plates. It is considered to have been obvious to have provided Green with a forward plate/washer secured with bolts as taught by Voissem in order to prevent accidental loss of the ejector and guide the rods such that they slide smoothly within the holes of the base of the cutter. Voissem and Green do not seem to explicitly state what the materials of the washers/plates are. It is considered to have been obvious to have experimented and made the washers of materials such as metal or wood, due to their qualities such as low cost and durability.
4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frevel (2435648) in view of Hougen (3559513). Frevel shows a hole saw having blades 12 in a circular

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arrangement on base 11 and an ejector. The ejector has a forward washer 14, a rearward washer 18, bolts 16 connecting the two washers, and a spring 19 for retracting the ejector. It's a bit of a stretch to call the teeth 12 of Frevel a "circular blade" as set forth in present claim 1.

Nevertheless, figure 17 of Hougen shows an ejector 126 biased forwardly within circular blade 20 by spring 130. The cutter of Hougen has numerous teeth 32, which spreads the wear of the cutting operation across many more teeth, providing a long lasting cutter. It is considered to have been obvious to have replaced the toothed/bladed cutter of Frevel with an annular hole cutter as shown by Hougen in order to spread the wear of the cutting operation over a larger number of cutting teeth. Frevel and Hougen do not seem to explicitly state what the materials of the washers/plates are. It is considered to have been obvious to have experimented and made the washers of materials such as metal or wood, due to their qualities such as low cost and durability.

5. Any inquiry concerning the content of this communication from the examiner should be directed to Daniel Howell, whose telephone number is 571-272-4478. The examiner's office hours are typically about 10 am until 6:30 pm, Monday through Friday. The examiner's supervisor, Boyer Ashley, may be reached at 571-272-4502.

In order to reduce pendency and avoid potential delays, Group 3720 is encouraging FAXing of responses to Office actions directly into the Group at FAX number to 571-273-8300. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a USPTO deposit account. Please identify Examiner Daniel Howell of Art Unit 3722 at the top of your cover sheet.



Daniel W. Howell
Primary Examiner
Art Unit 3722